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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,125

08/25/2003

Byoung-Woo Cho

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08/02/2006

STAAS & HALSEY LLP

SUITE 700

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WASHINGTON, DC 20005

EXAMINER

MORAN, KATHERINE M

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/647,125	Applicant(s) CHO, BYOUNG-WOO	
	Examiner Katherine Moran	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/5/06 has been entered. The amendment of 5/17/06 has been entered and claims 1, 2, 9-11, and 21 were amended.

Claim Objections

2. Claim 9 is objected to because of the following informalities: line 7: delete "to" and insert --top--. Appropriate correction is required.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 3 recites "the front part of the headband inclines toward a center of the crown." However, the specification recites this inclined position results from the sewing or attachment of the headband's bottom edge to the crown. Thus, any claim limitation drawn to the inclining of the front part without a previous recitation of the headband's bottom edge sewn to the crown in tension, does not have

antecedent. Claim 7 recites "the crown is a fixed size". Claim 11 recites "sunshield". Claim 15 recites "front part of the headband extends circumferentially in the crown along the bottom beyond edges of the visor". Claims 18-21 recite a method of making headgear, with claim 19 specifically reciting "attaching the visor to the crown before the headband is attached to the crown".

4. The disclosure is objected to because of the following informalities: par. 18, line 3: delete one of "extended" or "stretched".

Appropriate correction is required.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, recitation of claims 5 and 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2 recites the bottom edge "in contact" with the crown and in tension. However, the specification recites that the bottom edge is only in tension as a result of the stitching of the bottom edge to the crown. Thus, "in contact" is an attempt to broaden the relationship between the bottom edge and the crown.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13-16 recite the limitation "the crown". Claims 14 and 15 recite "the visor". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 6, 7, 11, 12, 14-16, 18, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (U.S. 1,892,515). Lee discloses the invention as claimed. Lee teaches headgear comprising a cap having a crown/sunshield 11 and visor 11b, and a headband attached to the crown and comprising a front part 12 formed of stretchable material and a rear part 10 formed of a non-stretchable material. The front part of the headband comprises a bottom edge attached to the crown in tension by stitching 13, with the front part extending circumferentially in the crown along the bottom to edges and beyond edges of the visor. The front part of the headband is stretched and sewn to the crown along a bottom peripheral edge of the crown and a bottom edge of the front part as shown in Figures 2 and 4. The crown is a fixed size in that the

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crown's size does not change. The method steps of claims 18 and 21 are inherent in the structure as taught by Lee.

12. Claims 1-5, 9, 11-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (U.S. 6,052,831). Park discloses the invention as claimed. Park discloses the invention as claimed. Park teaches headgear comprising a cap having a crown 1 and visor 2, and a headband attached to the crown. The headband comprises a front part 7 formed of stretchable material and a rear part formed of a non-stretchable material 3. The front part of the headband comprises a bottom edge attached to the crown in tension by stitching as shown in Figure 3, with the front part extending circumferentially in the crown along the bottom to edges and beyond edges of the visor, to the same degree shown and disclosed by the present invention. The front part of the headband is stretched and sewn to the crown along a bottom peripheral edge of the crown and a bottom edge of the front part as shown in Figure 3. The front part of the headband inclines toward a center of the crown away from a crown side wall.

13. Claims 1, 2, 6-8, 11, 12, and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kronenberger (U.S. 5,983,398). Kronenberger discloses the invention as claimed. Kronenberger teaches headgear comprising a cap 10 having a fixed size crown/sunshield 12 and an elastic visor 14, and a headband attached to the crown and comprising a front part 38 formed of stretchable material and a rear part 58, behind the front part in a circumferential direction of the headband, formed of a non-stretchable material. It is noted that depending upon which direction the cap is viewed from, either opposing portion of the cap could define the "front" or the "rear" since claim 1 does not

define the front and rear parts in relation to the visor. The front part 38 comprises a bottom edge in contact with the crown and in tension since the bottom edge is stitched at 48 to the crown portion 20. The front part of the headband is stretched and sewn to the crown along a bottom peripheral edge of the crown and a bottom edge of the front part. The term "stretched" is not given patentable weight in interpreting an apparatus claim, since it recites a process. The front part is capable of being stretched. The visor includes a bill portion extending outside the crown as shown in the drawings and an extended portion 66 extending into the crown. Claims 18-21 recite a method of making a headgear which is taught by Kronenberger.

Response to Arguments

14. Applicant's arguments filed 7/5/06 have been fully considered. With regard to Lee, Applicant argues that the stretchability of sheet 12 is limited by the stretchability of the fabric base. While this may be true, the sheet certainly has a property of being "stretchable". Applicant also states that if the fabric base is not stretchable, then the rubber would not be able to realize any of its elastic properties. The claim does not recite the term "elastic." An "elastic" property is different than a "stretchable" property since an elastic device would stretch and then return to its original state when the stretching forces are released or removed. Applicant also submits that Lee's band does not include a stretchable front part and non-stretchable rear part disposed behind the front part in a circumferential direction of the headband. It is true that the front and rear parts are disposed in a radial relationship. However, since both elements extend

circumferentially around the crown, any given portion of the rear part is disposed behind any given portion of the front part. With regard to Applicant's claim 2 reciting a process of attaching the headband's bottom edge to the crown in tension, it is noted that claim 2 is a product by process claim and as such, is limited by and defined by the process, though determination of patentability is based on the product itself. The structure implied by the process steps should be considered when assessing the patentability of product by process claims over the prior art. However, Applicant has failed to claim structure associated with the attachment "in tension". Thus, the stitched attachment of the bottom edge to the crown is a tensioned attachment. Applicant also states that there would be no need for the sheet 12 to be made of a stretchable material. The term "stretchable" is functional and in order for the prior art to meet this limitation, the prior art need only teach a material capable of stretch. Lee does include a rubberized, therefore stretchable, component.

Applicant argues that Park fails to teach a front part formed of stretchable material and a rear part formed of essentially a non-stretchable material. Park's headband includes a stretchable material 7 that extends along the lower periphery of the headband, including the front and rear headband parts. The headband also includes a non-stretchable material 3 extending along the lower periphery of the crown, including the front and rear headband parts. Thus, Park meets the limitations of independent claim 1. The claim has not defined the specific relationship between the front and rear parts in such a way that would overcome the prior art. As discussed above, since both

elements extend circumferentially around the crown, any given portion of the rear part is disposed behind any given portion of the front part.

Allowable Subject Matter

15. Claim 10 is allowed.

Conclusion

16. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (571) 273-8300.

General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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July 27, 2006

A handwritten signature in black ink, appearing to read "K Moran", with a stylized, cursive script.

Katherine Moran

Primary Examiner, AU 3765